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Patent Legal Staff
Eastman Kodak Company
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Rochester, New York 14650-2201

In re Application of :
Peter A. R. Bennett et al. :
Application No. 10/686,516 :
Filed: October 15, 2003 :
Attorney Docket No. HOR-16REISSUE :
(EKC 90372) :

DECISION DISMISSING
PETITION UNDER
37 CFR §1.183

This is a decision on the March 22, 2006, "Petition Under 37 CFR 1.183" requesting waiver of the 37 CFR 1.125(d) prohibition against the filing of a substitute specification in a reissue application and waiver of the 37 CFR 1.173(a)(1) requirement that a specification be furnished in the form of a copy of a printed patent, in double column format.

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office.

The petition is dismissed.

BACKGROUND

US Patent No. 6,303,271 to Peter A. R. Bennett et al. (the '271 patent) issued on October 16, 2001. A certificate of correction to the aforementioned patent was issued on May 21, 2002.

On October 15, 2003, Petitioner filed an application (assigned serial number 10/686,516) for reissue of the '271 patent. The application, as filed, was submitted in double column format but did not incorporate the changes to the specification and claims that became part of the issued patent by means of the certificate of correction.

As a result of applicant not actually inserting the changes made by the certificate of correction into the application pursuant to MPEP 1411.01, the application as filed was held not to conform with 37 CFR 1.173(a)(1). The Office action of 20 December 2005, informed applicant of this defect and required corrective action.

In response, on March 22, 2006, applicant filed the instant petition requesting waiver of rules 37 CFR 1.125(d) and 1.173(a)(1) to allow entry of a substitute specification which accompanied the petition. The petition was accompanied by a substitute specification.

DECISION

37 CFR 1.183 provides that “in an extraordinary situation, where justice requires” a regulation may be waived. An extraordinary situation is not present where there is an avenue for relief that does not necessitate waiver of any rules. See also *Cantello v. Rasmussen*, 220 USPQ 664 (Comr. 1982) for the principle that extraordinary relief will not normally be considered if the rules provide an avenue for obtaining the relief sought.

In this instance, applicant can accomplish the desired result – the entry of an amendment placing the application in proper format – within the ordinary procedures set out by the Office. This may be accomplished by providing replacement paragraphs incorporating the material in the certificate of correction to be entered without the use of underlining and bracketing.

In particular, applicant may submit an amendment which directs the Office to replace the appropriate paragraphs in order to conform the application to the patent including the changes of certificate of correction. For example, applicant can direct the Office to “replace the paragraph starting on Column 1, line 56, with the following paragraph...,” where the paragraph supplied would reflect the change to column 1 line 57 as per the certificate of correction (and as retyped in the substitute specification) with no underlining or brackets provided.

In view of the above discussion, waiver of the rules is inappropriate in this instance. Therefore, the petition is dismissed.

CONCLUSION

1. The petition under 37 CFR 1.183 to waive, for the instant application, the requirements of 37 CFR 1.125(d) and 37 CFR 1.173(a)(1) is dismissed.
2. Jurisdiction over the reissue application file is being returned to Group 1700.
3. Telephone inquiries with regard to this decision should be directed to Pinchus M. Laufer, Office of Patent Legal Administration, at (571) 272-7726.



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